REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments, which follow.

As correctly noted in the Office Action Summary, claims 16, 18 and 20-26 were pending. By the present response, claims 16, 18, and 25 have been amended, claims 20-21 and 23-24 have been canceled, and claims 27-31 added. Thus, upon entry of the present response, claims 16, 18, 22, 25, and 26-31 are pending and await further consideration on the merits.

Support for the present claim amendments can be found, for example, in at least the following portions of the original disclosure: Pg. 4, lines 11-19; Pg. 5, lines 2-9; Pg. 9, lines 2-22; and the original claims.

Applicant thanks Examiner Ouellette for the courtesies extended during the January 12, 2006 personal interview, the details of which are incorporated into the following remarks.

Entry of the forgoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons: the amendments due not necessitate a new search; clearly act to place the application in condition for allowance; and improves the form of the application for purposes of an appeal.

CLAIM REJECTIONS UNDER 35 U.S.C. §112, ¶2

Claim 18 stands rejected under 35 U.S.C. §112, ¶2 on the grounds set forth in paragraph 4 of the Official Action. In particular, it is asserted therein that there is insufficient and antecedent basis for the claim term "said client device," as it appears in claim 18. By the present response, claim 18 has been amended in a manner which, without narrowing the scope thereof, is believed to address the above-noted grounds for rejection. Thus, reconsideration and withdrawal of the rejections is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 16, 18 and 20-26 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,639,471 to Chait et al. (hereafter *"Chait et al."*) in view of U.S. Patent No. 4,685,059 to Yamamoto (hereafter *"Yamamoto"*) on the grounds set forth in paragraphs 7-27 of the Official

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Action. This rejection, as it would be applied to claims 16, 18 and 20-26, as amended, is respectfully traversed.

The present invention is directed to methods and arrangements for aggregating and pooling information within a communication system, and providing feedback with regard thereto.

A method performed according to the principles of the present invention as set forth in amended claim 16. Amended claim 16 recites:

> 16.   *A method of aggregating information from individuals in a population thereof, said method comprising:*
>   a)   *coupling a client device to each of a plurality of individuals in the population;*
>   b)   *prompting each individual for health-related information, and collecting the health-related information for each individual at a client device associated with each individual;*
>   c)   *sending the collected information from said client devices to a server device;*
>   d)   *extracting the collected information;*
>   e)   *generating statistical information from said collected information sent from a plurality of the client devices;*
>   f)   *distributing the statistical information to the individuals; and*
>   g)   *repeating steps a-d after a period of time has elapsed; wherein said statistical information comprises a first statistical measure for a first subpopulation of individuals within the plurality of individuals and a second statistical measure for a second subpopulation of individuals within the plurality of individuals;*
>   i)   *comparing the first statistical measure with the second statistical measure, and distributing a result of the comparison to the first subpopulation of individuals and to the second subpopulation of individuals; and*
>   j)   *awarding a benefit to one or more of the individuals based on the result of the comparison.*

A system constructed according to the principles of the present invention set forth in amended claim 18. Amended claim 18 recites:

> 18.   *A system for aggregating information for individuals in a population thereof, said system including:*
>   *a client device disposed for collecting an individual value comprising health-related information for each of plurality of individuals in the*

population in response to a prompt received by the client device for the health-related information;

    a server device, disposed for receiving said individual values, for determining at least one aggregate value in response thereto; and

    wherein said server device distributes said at least one aggregate value to a plurality of said client devices;

    wherein each of the client devices repeats collecting the individual value for the individual associated therewith, said server device repeats the determination of at least one aggregate value in response to the repeated collection performed by the client devices and said server device distributes the repeated determination of the at least one aggregate value to a plurality of said client devices, when a preset period of time has elapsed since the previous collection of individual values, determination of at least one aggregate value and distribution of said at least one aggregate value;

    wherein the at least one aggregate value comprises a first statistical measure for a first subpopulation of individuals within the plurality of individuals and a second statistical measure for a second subpopulation of individuals within the plurality of individuals;

    wherein the server device is configured to compare the first statistical measure with the second statistical measure, and distribute a result of the comparison to the first subpopulation of individuals and to the second subpopulation of individuals; and

    wherein the server device is further configured to award a benefit to one or more of the individuals based on the result of the comparison.

As expressly admitted in paragraphs 11 and 21 of the final rejection, neither *Chait et al.* nor *Yamamoto* disclose, or even suggest, all of the elements required by claims 16 and 18. In particular, as discussed during the interview, the proposed combination of *Chait et al.* with *Yamamoto*, even if appropriate, fails to establish a *prima face* case of obviousness because the proposed combination fails to disclose or suggest at least "distributing statistical information to the individuals" (as recited in claim 16) or "said server device distributes said at least one aggregate value to a plurality of said client devices" (as recited in claim 18).

In order to establish a *prima face* case of obviousness, all claimed limitations must be taught or suggested by the applied prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Since the grounds for rejection admittedly fail to meet this requirement, the rejection is improper and should be withdrawn.

In an attempt to fill the hole contained in the teaching of the prior art references, the grounds for rejection are improperly augmented by a conclusory unsupported assertion based on hindsight:

> However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to publish the clinical trial/study results, especially to those who participated in the clinical/study. Furthermore, it would have been obvious to transmit the findings of the study electronically to the participant, as it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art (citation omitted) (*See, e.g.,* paragraphs 12 and 22 of the Official Action).

As evident from the above, no reference is cited or rational given, to support the conclusory assertion of obviousness. To the extent that the grounds for rejection rests upon the allegedly "well-known" prior art, it is incumbent upon the examiner to take official notice of what is allegedly "well-known" (*See, e.g.,* MPEP §2144.03). Thus, the grounds for rejection are improper for this additional reason. *See also,* 37 C.F.R. §1.104(c)(2).

Moreover, it is incumbent upon the Examiner, when challenged, to provide documentary evidence to support the Examiner's conclusions. *See,* MPEP §2144.03(C). Thus, to the extent that the grounds for rejection could possibly be construed as taking official notice of the facts asserted therein, applicant traverses any such assertion of official notice. Specifically, the above quoted grounds for rejection inadequately explain why would have been obvious to one of ordinary skill in the art to "publish" the results of a clinical trial to the participants thereof. No explanation or information is given as to the context of any such well-known "publication" such that an assessment as to whether such well-known publication would be analogous to the teachings of *Chait et al.* and/or *Yamamoto.*

To the extent of the grounds for rejection rests upon the Examiner's personal knowledge, applicant requests that the examiner execute an affidavit or declaration setting forth the personal knowledge being relied upon. *See,* 37 C.F.R. §1.104(d).

The teachings of multiple prior art references can be combined only when there is a suggestion or incentive to do so. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, the prior art contains none. Instead, the grounds for rejection rely on hindsight. Failure by the

patent office to provide the necessary suggestion or motivation creates a presumption that the combination of references selected is based on hindsight. *In re Rouffet*, 149 F.3rd 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Not only is an inadequate rational given to explain <u>why</u> it would have been obvious to one of ordinary skill in the art to make the claimed invention, there is an equally persuasive disincentive to "publish." Namely, the teachings of *Chait et al.* which are cited to support the claims for rejection deal with a clinical trial conducted in conjunction with a diet program. The clinical trials taught by *Chait et al.* include the collection of voluminous amounts of personal medical information in connection with the study (*see, e.g.,* columns 61-68). The grounds for rejection fail to consider the motivation to preserve the privacy of those participants in the clinical trials by not publishing their personal medical information.

As also discussed during the interview, the grounds for rejection are also defective because they rest upon the presumption that the "publishing" of the clinical trial results satisfies the requirements of claims 16 and 18. However, claim 16, for example, requires the <u>distribution</u> of information <u>to the</u> individuals. Taken in light of the specification, the above quoted limitation clearly implies that the information is specifically brought to the direct attention of the individuals who have provided health related information. Thus, general publication, such as in a medical journal or newspaper, would not satisfy the requirements of claim 16. Similarly, claim 18 requires that the server distribute at least on aggregate value to the plurality of the client devices. Again, general publication of such information would not satisfy this aspect of claim 18.

The grounds for rejection also fail to explain how the server would distribute the information to the client devices. In this regard, while it is noted that it is generally alleged it would have been obvious to transmit the finding of the study "electronically" this is also insufficient to satisfy the specific requirements of claim 18. There could possibly be many means of publishing something electronically, however, these various means would not necessarily satisfy the specific arrangement of the system set forth in claim 18.

As evident from the above, the method of claim 16 requires "comparing the first statistical measure with the second statistical measure, and distributing a result of the comparison to the first subpopulation of individuals and to the second subpopulation of individuals" and "awarding a

benefit to one or more of the individuals based on a result of the comparison." Similarly, the system of claim 18 requires that "the server device is configured to compare the first statistical measure with the second statistical measure, and distribute a result of the comparison to the first subpopulation of individuals and to the second subpopulation of individuals" and "wherein the server device is further configured to award a benefit to one or more of the individuals based on the result of the comparison." In this regard, it is asserted, for example, in paragraph 13 of the Official Action that:

> *Chait et al.* and *Yamamoto* disclose comparing the first statistical measure with the second statistical measure, and distributing a result of the comparison to the first subpopulation of individuals and to the second subpopulation of individuals.

Columns 67-68 of *Chait et al.* are cited in support of the above-quoted assertion. However, applicant finds no such teaching contained in *Chait at el.* Namely, *Chait et al.* does not teach distributing results of the comparison of a first subpopulation of individuals and to the second subpopulation of individuals as alleged. The Examiner is requested to specifically identify which part of *Chait et al.* is being relied upon to satisfy this aspect of the presently claimed invention.

Further, it is acknowledged in paragraph 14 of the official action that "Chait et al. and Yamamoto failed to expressly disclose awarding a benefit to one or more of the individuals based on the result of the comparison." Despite this additional acknowledged deficiency in the grounds for rejection, it is nonetheless asserted that "it would've been obvious to one of ordinary skill in the art of the time the invention was made to reward the participants of a clinical study with either monetary or physical awards, to show appreciation for their efforts in the study" (paragraph 15 of the official action). Again, no reference is cited to support the conclusory assertion of obviousness. The motivation for the proffered modification is not taken from the prior art, rather it is based on an impermissible hindsight reconstruction of the prior art. The rejection is improper and must be withdrawn. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

For at least the reasons noted above, the rejection of claims 16 and 18 are improper and should be withdrawn. Claims 20-27 depend either directly or indirectly upon claim 16 or claim18. Thus, these claims are also allowable for at least the same reasons noted above.

Newly presented claims 28-31 also include the limitations noted above. Thus, these claims are also distinguishable over the applied prior art for at least the same reasons discussed above.

CONCLUSION

Based on the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-2228, under Order No. 014030.0118N2US from which the undersigned is authorized to draw.

Dated: ___2-2-06___   Respectfully submitted,

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